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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,257	05/24/2000	Janez Skubic	34650-581USPT	5563

7590 12/31/2002
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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,257

Applicant(s)

SKUBIC ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19,20,23, and 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,16,18,21,22,24,25,27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-6,8-15,17 and 29-39 is/are rejected.
- 7) ☒ Claim(s) 13 and 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3621

DETAILED ACTION

Status

Claims 19-20, 23 and 26 have been canceled

Claims 1-18, 21-22, 24-25 and 27-39 remain pending

Response to Arguments

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The applicants arguments filed on October 16, 2002 have been fully considered.

Claim 1

The applicant states that the recited references do not describe storing an electronic portrait in a personal device.

The examiner replies that as per *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir 1992) A prior art reference is analogous if the reference is reasonably pertinent to the particular problem with which the inventor is concerned. None of the cited references (Pare Jr, et al. US patent 5,870,723, Houvener et al US Patent 6,202,055, and Maes et al. US Patent 6,016,476) singularly meet all of the limitations of claim 1, however when combined under 35 USC 103 the limitations of the claimed invention are met. (see following rejection)

Maes et al. US Patent 6,016,476 discloses "The present invention is a portable client PDA with a touch screen or other equivalent user interface and having a microphone and local central processing unit (CPU) for processing voice commands and for processing biometric data to provide user verification." (Abstract)the examiner states that this reference discloses both a personal device (a PDA) and a electronic portrait (biometric data)

The applicant states that the Maes et al reference do not describe storing an electronic portrait in a personal device to enable access of the electronic portrait by a seller via wireless interface during a transaction.

Art Unit: 3621

The examiner replies that as previously stated Maes et al. discloses storing an electronic portrait in a personal device, furthermore Maes et al discloses a wireless interface "The PDA includes a modem, a serial port and/or a parallel port so as to provide direct communication capability with peripheral devices (such as POS and ATM terminals) and is capable of transmitting or receiving information through wireless communications such as radio frequency (RF) and infrared (IR) communication." Maes et al discloses an alternate embodiment of the invention that enables access of the electronic portrait by a seller during a transaction. (column 12, lines 30-39). See following rejection

Claim 9

Claim 9 and all claims dependant therefrom are rejected for at least the same reasons as claim 1

Claim 13

Claim 13 is allowed

Claim 18

Claim 18 is allowed

Claims 21-22,24-25 and 27 are allowed as they are dependant on claim 18.

Claim 29

Claim 29 and all claims dependant therefrom are rejected for at least the same reasons as claim 1

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr, et al. (US patent 5,870,723) in view of Houvener et al (US Patent 6,202,055) and further in view of Maes et al.(US Patent 6,016,476)

As per claim 1

Pare, Jr et al ('723) discloses a method for enabling identification of a buyer during a transaction, comprising the steps of:
generating an electronic portrait of a buyer,(column 15, lines 64-66)

Art Unit: 3621

transmitting the electronic portrait to a seller via a wireless interface during a transaction.(figure 2)

Pare, Jr et al ('723) does not specifically disclose the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller. Houvener et al ('055) discloses the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller;(column 3, lines 22-29) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with Houvener et al's teaching of enabling generation of a physical identifier for comparison to the buyer by a seller in order to prevent sellers from being the victims of fraudulent activities performed y customer who misrepresent themselves.

Pare, Jr et al ('723) does not specifically disclose storing the electronic portrait in a personal device to enable access of the electronic portrait by a seller during a transaction. Maes et al. ('476) discloses storing the electronic portrait in a personal device (Abstract) to enable access of the electronic portrait by a seller during a transaction; (column 12, lines 30-39, also column 5, lines 60-63) It would be obvious to one having ordinary skill in the art at the time of the invention to further combine Pare Jr. et al's method with Maes et al's teaching storing the electronic portrait to enable access of the electronic portrait by a seller during a transaction in order to provide to sellers with a certification of the customers authenticity.

As per claim 2,

Pare, Jr et al ('723) discloses the method of Claim 1,
wherein the step of storing further comprises the step of storing the electronic portrait within a certificate in the personal device.(figure 6)

As per claim 3,

Pare, Jr et al ('723) discloses the method of Claim 1,
wherein the step of storing further comprises the step of storing the electronic portrait in an encrypted format within the personal device.(figure 5)

As per claim 4,

Pare, Jr et al ('723) discloses the method of Claim 1,
wherein the electronic portrait comprises at least one of:
an electronic photo of the buyer; a graphic imprint of the buyer;
a mathematical imprint of the buyer;
a verbal description of the buyer;
an electronic audio imprint of the buyer; and an electronic
video imprint of the buyer.(column 15, lines 60-67; column 16, lines 1-4)

As per claim 5,

Pare, Jr et al ('723) discloses the method of Claim 1,
Pare, Jr et al ('723) does not specifically disclose wherein the personal device comprises at least one of a mobile telephone or an electronic personal device. Maes et al. ('476) discloses wherein the personal device comprises at least one of a mobile telephone or an electronic personal device.(column 3, lines 34-37; figure 3 label 10) It would be obvious to one having ordinary

Art Unit: 3621

skill in the art at the time of the invention to combine Pare Jr. et al's method with Maes et al's teaching of using a mobile phone or electronic personal device order to provide authentication services to consumers who are mobile.

As per claim 6,
Pare, Jr et al ('723) discloses the method of Claim 1,
further including the step of placing the electronic device in a shielded area associated with the seller prior to transmitting the electronic portrait.(column 6, lines 12-21,30-31)

As per claim 35,
Pare, Jr et al ('723) discloses the method according to Claim 1, further including the step of including an encryption key with the electronic portrait.(figure 5)

As per claim 36,
Pare, Jr et al ('723) discloses the method according to Claim 1, further including the step of including a public key with the electronic portrait.(column 19, lines 30-37)

As per claim 37,
Pare, Jr et al ('723) discloses the method according to Claim 1,
Official notice is taken that it is old and well know in the art of customer authentication to include a private key associated with the electronic portrait. It would be obvious to one having ordinary skill in the art at the time of the invention to include a private key associated with the electronic portrait in order to allow the customer to prove his identity.

Claims 8,17, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr, et al. (US patent 5,870,723) in view of Houvener et al (US Patent 6,202,055) and further in view of Maes et al.(US Patent 6,016,476) and further in view of Philips Bluetooth.

As per claim 8,
Pare, Jr et al ('723) discloses the method of Claim 1,
Pare, Jr et al ('723) does not specifically discloses wherein interface comprises a Bluetooth interface. Philips Bluetooth discloses wherein interface comprises a Bluetooth interface. It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with the Philips Bluetooth teaching of using a Bluetooth interface in order to provide authentication services to consumers who are mobile.

As per claim 17,
Pare, Jr et al ('723) discloses the method of Claim 9,
Pare, Jr et al ('723) does not specifically discloses wherein interface comprises a Bluetooth interface. The Philips Bluetooth article discloses wherein interface comprises a Bluetooth interface. It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with the Philips Bluetooth article teaching of using a Bluetooth interface to provide authentication services to consumers who are mobile.

Art Unit: 3621

As per claim 34,

Pare, Jr et al ('723) discloses the electronic personnel device of Claim 29, Pare, Jr et al ('723) does not specifically disclose wherein the wireless communication link comprises a Bluetooth interface. BT article discloses wherein interface comprises a Bluetooth interface. It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with BT article teaching of using a Bluetooth interface in order to provide authentication services to consumers who are mobile.

Claims 9-12,14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr, et al. (US patent 5,870,723)

As per claim 9

Pare, Jr et al ('723) discloses a method for enabling identification of a buyer during a transaction, comprising the steps of:

receiving an electronic portrait from a personal device of the buyer via a short range wireless interface, (figure 2)

generating the physical identifier from the received electronic portrait; (column 15, lines 64-66)

Pare, Jr et al ('723) does not specifically disclose the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller. Houvener et al ('055) discloses the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller;(column 3, lines 22-29) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with Houvener et al's teaching of enabling generation of a physical identifier for comparison to the buyer by a seller in order to prevent sellers from being the victims of fraudulent activities performed by customer who misrepresent themselves.

Official notice is taken that it is old and well known in the art of customer authentication to displaying the physical identifier to the seller using equipment of the seller. It would be obvious to one having ordinary skill in the art at the time of the invention to display the physical identifier to the seller using equipment of the seller in order to reduce the amount of equipment in the consumer's possession

Official notice is taken that it is old and well known in the art of customer authentication to complete the transaction if the physical identifier corresponds to the buyer. It would be obvious to one having ordinary skill in the art at the time of the invention to complete the transaction if the physical identifier corresponds to the buyer in order for the seller to make a profit.

As per claim 10

Pare, Jr et al ('723) discloses the method of Claim 9, Official notice is taken that it is old and well known in the art of customer authentication to interconnect with a personal device containing the electronic portrait via the bluetooth interface. It would be obvious to one having ordinary skill in the art at the time of the invention to interconnect with a personal device containing the electronic portrait via the bluetooth interface in order allow the consumer to have the convenience of not carrying a cable.

Art Unit: 3621

As per claim 11

Pare, Jr et al ('723) discloses the method of Claim 9,

Official notice is taken that it is old and well known in the art of customer authentication to decrypt the electronic portrait. It would be obvious to one having ordinary skill in the art at the time of the invention to decrypt the electronic portrait to allow the portrait to be rendered in a human readable format.

As per claim 12,

Pare, Jr et al ('723) discloses the method of Claim 9,

wherein the electronic portrait comprises at least one of:

an electronic photo of the buyer; a graphic imprint of the buyer;

a mathematical imprint of the buyer;

a verbal description of the buyer;

an electronic audio imprint of the buyer; and an electronic

video imprint of the buyer.(column 15, lines 60-67; column 16, lines 1-4)

As per claim 14

Pare, Jr et al ('723) discloses the method of Claim 9,

Official notice is taken that it is old and well known in the art of customer authentication to comparing the physical identifier to the buyer. It would be obvious to one having ordinary skill in the art at the time of the invention to compare the physical identifier to the buyer in order to prevent fraud.

As per claim 15,

Pare, Jr et al ('723) discloses the method of Claim 9,

further comprises receiving from the personal device which is located in a shielded area.
(column 6, lines 12-21,30-31)

Claims 29-31,33,38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr, et al. (US patent 5,870,723) in view of Houvener et al (US Patent 6,202,055)

As per claim 29,

Pare, Jr et al ('723) discloses an electronic personal device enabling identification of a buyer during a transaction comprising:

a memory;(column 12 line 30)

an electronic portrait stored within the memory,(column 15, lines 64-66)

Pare, Jr et al ('723) does not specifically disclose the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller. Houvener et al ('055) discloses the electronic portrait enabling generation of a physical identifier for comparison to the buyer by a seller;(column 3, lines 22-29) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Pare Jr. et al's method with Houvener et al's teaching of enabling generation of a physical identifier for comparison to the buyer by a seller in order to prevent sellers from being the victims of fraudulent activities performed by customer who misrepresent themselves.

Art Unit: 3621

transmission circuitry enabling a wireless communications link between the buyer and the seller for transmission of the electronic portrait.(column 14, lines 5-16)

As per claim 30,

Pare, Jr et al ('723) discloses the method according to Claim 29, further including a public key with the electronic portrait.(column 19, lines 30-37)

As per claim 31,

Pare, Jr et al ('723) discloses the electronic personal device of Claim 29, wherein the electronic portrait is part of a certificate.(figure 6)

As per claim 33,

Pare, Jr et al ('723) discloses the method of Claim 29, Wherein the personal device comprises a mobile telephone.(column 14, lines 20-32)

As per claim 38,

Pare, Jr et al ('723) discloses the method according to Claim 29,

Official notice is taken that it is old and well know in the art of customer authentication to include a private key associated with the electronic portrait. It would be obvious to one having ordinary skill in the art at the time of the invention to include a private key associated with the electronic portrait in order to allow the customer to prove his identity.

As per claim 39,

Pare, Jr et al ('723) discloses the method according to Claim 1, further including an encryption key associated with the electronic portrait.(figure 5)

Allowable Subject Matter

Claim 7,16, 18, 21-22, 24-25, and 27-28 are allowed

Claims 13 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

December 16, 2002

JOHN W. HAYES
John W. Hayes
Primary Examiner